

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

PCT

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

**FOR FURTHER ACTION**  
See paragraph 2 below

International application No.  
PCT/EP2004/052167

International filing date (day/month/year)  
14.09.2004

Priority date (day/month/year)  
19.09.2003

International Patent Classification (IPC) or both national classification and IPC  
E21B19/00, E21B33/08

Applicant  
WEATHERFORD/LAMB, INC.

### 1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1b/s(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

### 3. For further details, see notes to Form PCT/ISA/220.



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**Box No. I Basis of the opinion**

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1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
 This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. **type of material:**  
 a sequence listing  
 table(s) related to the sequence listing
  - b. **format of material:**  
 in written format  
 in computer readable form
  - c. **time of filing/furnishing:**  
 contained in the international application as filed.  
 filed together with the international application in computer readable form.  
 furnished subsequently to this Authority for the purposes of search.
3.  In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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**Box No. II Priority**

1.  The following document has not been furnished:

- copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).  
 translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2.  This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or  
industrial applicability; citations and explanations supporting such statement**

**1. Statement**

|                               |             |                         |
|-------------------------------|-------------|-------------------------|
| Novelty (N)                   | Yes: Claims | 3, 4, 6-9, 11-13, 16-20 |
|                               | No: Claims  | 1, 2, 5, 10, 14, 15     |
| Inventive step (IS)           | Yes: Claims |                         |
|                               | No: Claims  | 1-20                    |
| Industrial applicability (IA) | Yes: Claims | 1-20                    |
|                               | No: Claims  |                         |

**2. Citations and explanations**

**see separate sheet**

**Box No. VII Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

**see separate sheet**

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure:  
D1:US- 6 263 982.  
D2:US- 5 076 364
2. Document D1 which is considered the most relevant state of the art discloses (claim 1; fig, 1-8) a method for drilling in a floor of an ocean from a structure (S) floating at a surface of the ocean using a rotatable tubular (14) and pressurised drilling fluid, comprising the steps of:  
positioning a housing (20) above a portion of a riser (R);  
allowing the floating -structure (S) to move independent of the housing (20);  
communicating the pressurised drilling fluid from the structure (S) to an annulus of the riser (R) surrounding the rotatable tubular (14), comprising the steps of:  
compensating for relative movement of the structure (S) and the housing (20),  
comprising the steps of:  
attaching a flexible conduit (30) between the housing (20) and the floating structure (S); and  
moving the pressurised drilling fluid through the flexible conduit (30) to the housing (20), and  
moving the pressurised drilling fluid in the housing (20) into the annulus (1350).  
A method with all the features defined in claim 1 of the present application is known from the above cited prior art document. Therefore claim 1 does not meet the requirements of Article 33.2 PCT.
3. The subject-matter of claim 2 is disclosed in D1 (column 5, lines 49-53). Therefore claim 2 also does not meet the requirements of Article 33.2 PCT.
4. The additionally specified features of claims 3 and 4 have already been employed

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in D2 (column 12, lines 49-55) in a similar offshore drilling rig and for the same purpose of contacting a subsea formation with a particular package (pill) of fluid. Therefore the subject-matter of these claims does not meet the requirements of Article 33.3 PCT.

5. Even though claims 5, 10, 13 and 14 do not meet the conciseness requirement of Art. 6 PCT (see Point VII), they will be briefly examined:  
The subject-matter of claims 5 and 14 is also disclosed in D1 (claim 1, fig. 1-8, column 4, lines 45-61). Therefore these claims also do not meet the requirements of Art. 33.2 PCT.  
Claim 1 includes all the features of claim 10 and therefore claim 10 also lacks the novelty requirement of Art. 33.2 PCT vis à vis D1.  
Claim 13 does not meet the requirements of Art. 33.3 PCT (see D1 (claim 1), D2 (column 5, lines 49-53) and the reasoning of Point 4 !).
7. Document D1 also discloses (claim 1, fig. 1-8) a system adapted for use with a structure (S) for drilling in a floor of an ocean using a rotatable tubular (14) and drilling fluid when the structure (S) is floating at a surface of the ocean, the system comprising:  
a housing (20) adapted for positioning above a portion of a riser (R), the housing (20) having a first housing opening (20A) to receive the drilling fluid from the structure (S), and  
an assembly (10A) removably positioned within the housing (20), the assembly (10A) having a sealing member (38, 42) that rotates relative to the housing (20) and seals the tubular (14) when the tubular is rotating;  
wherein the first housing opening (20A) is in fluid communication with an annulus of the riser (R) surrounding the rotatable tubular (14), and  
wherein the floating structure (S) moves independent of the assembly (10A) when the tubular (14) is rotating.  
A system having all the features defined in claim 15 of the present application is known from the above cited prior art document. Therefore claim 15 does not meet the requirements of Article 33.2 PCT.
8. The remaining dependent claims 6-9, 11, 12, 16-20 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty or inventive step, see documents

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D1 and D2 and the corresponding passages cited in the Search report.

**Re Item VII**

To satisfy the conciseness requirement of Art. 6 PCT the set of claims should include only the minimum necessary number of independent claims in any one category, with dependent claims as appropriate, Rule 6.(4) PCT. Said requirement is not satisfied by claims 1, 5, 10, 13 and 14 as in the present case it is considered appropriate to use only one independent claim in any category.

Independent claims are not in two-part form in accordance with Rule 6.3(b) PCT, which in the present case would be appropriate, with those features known in combination from the prior art document D1 being placed in the preamble (Rule 6.3(b)(I) PCT) and with the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).